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PATENT

Docket No. SA9-98-160

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Robert Douglas Case et al)
Serial No.: 09/191,256)
Filed: November 12, 1998) Group Art
For: SYSTEM AND METHOD FOR REMOTELY) Unit: 2154
ACCESSING A CLIENT IN A CLIENT)
SERVER ENVIRONMENT)
Examiner: Zarni Maung)

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APPELLANT'S RESPONSE TO THE EXAMINER'S ANSWER

Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

This brief is being filed under 37 CFR 1.193 in response to the Examiner's Answer of

March 16, 2004.

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SUMMARY

In view of the foregoing, each of the claims on appeal has been improperly rejected. Reversal of the Examiner's rejection and allowance of the pending claims 1-22 is respectfully requested. The Examiner's Answer adds little over the original rejection of the claims. It still remains unclear how two prior art references directed to different problems from each other and the invention and with greatly differing structure would have properly suggested the particular arrangement of the present invention. The Examiner's Answer points generally to large sections of the prior art and conclusively states that teachings that render the invention obviousness are somewhere in there. Applicants are left to try to attempt to decipher how the cited passages apply to the present invention.

The Answer, like the rejections before it, does not establish a prima facie case of obviousness under 35 U.S.C. 103. The two references combined do not teach or suggest all elements of the claimed invention. The two references are also not properly combined, as they are absent a sufficient motivation or suggestion to combine the references. The combination so randomly picks and chooses from among the two references, that one could obtain the claimed invention only with hindsight and use of the application as a road map. Furthermore, the combination is so tortuously predicated on picking certain elements here and throwing out other element there, that it requires a total reconstruction or design of the two references in order to combine them, which is impermissible.

ARGUMENTS

A. Claim 1

The invention is directed to allowing a user such as an administrator to remotely access a client computer with the use of a browser. The user can direct operations on one or more clients in this manner, including communications with a server for e.g., backing up and restoring files. This is done with the use of a browser on the client that is configured to request remote access on the client. The client is provided with a listening program that is responsive to the requests for remote access. The client is configured to respond to the requests, to establish direct communications with the client, and invoke a client agent for communicating with the browser and the server. See, abstract, claim 1, Figure 2.

The primary reference, Scherpbier, allows a pilot browser to send URLs of web pages to a server for ultimate display on a passenger browser. There is no control over or direct contact with the passenger computer from the pilot browser. Scherpbier discloses a pilot machine with a browser, a server, a passenger machine with a browser, a pilot applet, and a passenger applet. See, Abstract, Figure 2.

In operation, the passenger 24 downloads the applet from the server 16. The pilot transmits a URL to the server 12. The server retrieves the associated web page 14a, sanitizes the web page,

and makes the sanitized version available to the passenger 24 for viewing on the passenger display 24a.

Claim 1 of the present application recites a browser for requesting remote access. Scherpbier teaches two browsers, 20, 26. Neither request remote access. The lengthy passage cited by the examiner for this prospect, column 3, line 40 to column 4, line 50, teaches communication between the pilot web browser 20 and the control module 16, (column 3, lines 59 – 61) and causing the passenger browser 26 to communicate with the control module 16 (column 3, line 67 – column 4, line 1). The discussed communications are not requests for remote access. The passenger browser sends a URL to the control module 16 of the server 12 (Block 70 of Figure 1, column 5; lines 36-42). The passenger computer receives a sanitized version of the web page 14a from the control module 16 (Block 76 of Figure 5; column 5, lines 50-54).

Requesting remote access under the present invention involves requesting access to processes on another computer over a distributed communications link. Applicants believe this to be the generally accepted industry meaning of the term. In the specification, remote access is discussed in one form as involving a remote log-in to the remote client machine. See, page 3, line 7 through page 4, line 3. Requests for remote access are disclosed at page 13, lines 14-21 and Column 18, 11-16 as being a request for a user to access a client over a network. The request is in the form of a machine name and a port number. Id. In the context of the disclosure, this remote access is used to conduct operating system type operations such as backing up and

restoring files (Page 17, lines 12-13). Scherpbier teaches no such requests, and especially, no such requests as being made from a browser.

Claim 1 also requires that the client machine comprise a listening program and a client agent.

The client agent is invoked by the listening program, and the listening program is responsive to requests for remote access. Claim 1, lines 4-6. The Examiner's Answer states that disclosure of this element is found in Figure 1 and the specification at column 3 line 40 to column 6 line 54.

In Scherpbier, The control module 16 prompts the applet 28 to load the sanitized web page 14a from the control module. Thus, it appears that the Examiner is considering the passenger browser 26 to be the listening program and the passenger applet 28 to be the client agent, as the claim requires that the listening program must invoke the client agent.

Even if this is the case, the invoked client agent must communicate with the browser and the server as required by claim 1. The applet appears to communicate with the control module 16 of the server, but does not communicate with the pilot browser 20 (allegedly, the browser for requesting remote access). Thus, the client agent as recited by claim 1 is not disclosed in Scherpbier. Nor does the Examiner's Answer identify a thusly configured client agent in Kalajan or the other prior art of record.

Claim 1 also requires that the listening program be configured to establish direct communications with the browser and be responsive to requests for remote access. If the listening program is considered to be the passenger browser, which is the only likely interpretation, because the

listening program must invoke the client agent, then the passenger browser must be responsive to requests for remote access and establish direct communications with the browser. Such is not the case. The examiner concedes that the passenger applet and browser do not directly communicate with the pilot browser. But neither do they respond to a request for remote access.

Then Examiner Answer cites Kalajan for the direct communications between the listening program (passenger browser) and the browser (pilot browser). Kalajan is directed to a method for redirecting communications on a network between a client and network resources. A specific example is given of using an off-the-shelf e-mail program from a remote location and redirecting message traffic between the e-mail program on the local client and a home server (see Kalajan Abstract, Figure 1, Column 4, line 29-42). Kalajan involves a server, a client, and a browser, but the browser is local to the client. A message redirection application 20 is (apparently) cited as equivalent to the listening program. The message redirection application is in communication with the web browser, because it is part of the web browser, as shown in Figure 1. The message redirection application 20 within the server 12 does not communicate with the web browser 22, because it is only a copy for download to the client 10 (column 3, lines 40-47). Thus, the message redirection application communicates directly to the web browser 22, but not remotely.

Examination of claim 1 reveals that the listening program must communicate with the browser directly and remotely, because the browser must request remote access and the listening program must be responsive to requests for remote access from the browser. Because the message

redirection application 20 is located within the web browser 22, it cannot communicate remotely with the web browser. Furthermore, to make it do so, is to take it out of context of the invention of Kalajan and to destroy the utility of Kalajan, which is to receive network messages and redirected them from a local port or address to a destination network resource across a network in a manner completely transparent to the user. Column 2, lines 48-51).

Furthermore, putting the message redirection application 20 that is within the browser 22 into the passenger computer 24 of Scherpbier would destroy the utility of Scherpbier, because the pilot browser 20 would no longer be remote, and a user of the pilot computer 18 could not then use the pilot browser 20 to send URLs for display on a passenger computer 24. References are not properly combinable where a proposed modification would render one of the references unsuitable for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Additionally, because the two cited prior art references are so different from the present invention, the Examiner must pick and choose between the two references to come up with anything even remotely resembling the present invention. For instance, the Examiner's Answer chooses to use only the direct communication between the message redirection application and the web browser of Kalajan, but elects not to use the fact that the two are located together on the client 10. Additionally, the Answer ignores the fact that the message redirection application which is asserted as the a listening program is not responsive to requests for remote access as required in claim 1. Nor does it invoke a client agent as required by claim 1.

The Answer randomly picks and chooses from the prior art without apparently any guidance other than hindsight and the use of Appellant's application as a road map. Yet the Answer asserts that two disparate references directed to different problems, which are also different from the invention can be selectively combined to render the claimed invention obvious. Just such an act has been held to be an improper combination of references. In *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (C.C.P.A. 1959), the court held that "the combination of Jepson with Chinnery et al. is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Chinnery et al. as well as a change in the basic principles under which the Chinnery et al. construction was designed to operate." Such is the case here.

In addition, the extensive picking and choosing the examiner has espoused is not properly supported by a motivation or suggestion to combine the references. The Examiner's Answer gives as its only a motivation or suggestion to combine that it would have been obvious to combine the references ... "because Kalajan suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64). One of ordinary skill in the art would have been motivated to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser so that resources can be distributed transparently to network users." Examiner's Answer at page 5.

The Answer's cited passage is taken out of context. The actual passage, located at column 2, lines 49-51, states in full: "Network messages can be redirected from a local port or address to a destination network resource across a network in a manner completely transparent to the user." Thus, Kalajan is espousing the advantage of his invention that network messages can be redirected from a local port or address to a destination network resource. Yet neither the appellant's application nor Scherpbier are directed to this problem. Neither does this reference suggest lifting the particular element of the web browser 22 and the message redirection application 20 communicating directly with each other to place it in the structure of Scherpbier as the Examiner seems to assert. Once again, taking the suggestion of this passage and redirecting network messages from a local port or address would destroy the intended utility of both the appellant's invention and Scherpbier. Furthermore, this passage, rather than suggesting the invention, seems to be teaching away from the present invention.

What the examiner seems to be stating is a general obvious-to-try rationale. Yet, such a basis for combination is prohibited. Here, the examiner is suggesting that this single element can be lifted from Kalajan with no instruction for how to do so (or as stated above, motivation for doing so). This argument failed in *Ex Parte Obukowicz*, 27 USPQ2d 1063 (B.P.A.I. 1992), where the court stated:

The specific Statement by Dean is not a suggestion to insert the gene into the chromosome of bacteria and apply that bacteria to the plant environment in order to protect the plant. At best, the Dean statement is but an invitation to scientists to explore a

new technology that seems a promising field of experimentation. The Dean statement is of the type that gives only general guidance and is not at all specific s to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach “obvious to try” but it does not make the invention obvious. *Id.* at 1065.

B. Claims 2-21

Claims 2-9 which are addressed in the Examiner’s Answer are considered allowable for the reasons stated in the Appeal Brief. The Examiner’s Answer dismisses claims 9-22 as for not teaching or further defining over the limitations recited in claims 1-8 and rejects them for the same reasons set forth in claims 1-8 (Examiner’s Answer page 7). Nevertheless, these claims each contain limitation different from and in addition to the limitations of claims 1-8.

For instance, claim 9 recites invoking the client agent with an application programming interface, a limitation that is not addressed in the Examiner’s Answer. Claim 10 recites communicating between the client agent and a server over the network. Claim 11 recites sending from the client agent to the browser a graphical user interface that looks like a GUI on the client machine when running at the browser. Claim 12 recites wherein the graphical user interface is implemented in a JAVA applet. Claim 13 recites that the communications of claim 10 are comprised of performing client functions from the browser.

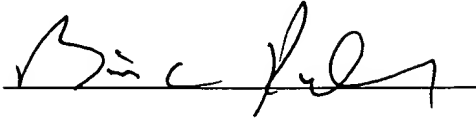
Claim 14 recites that the communications of claim 13 are comprised of retrieving files from the server to the client machine. Claim 15 recites that the communications of claim 13 are further comprised of backing up files on the client machine to the server. Claim 16 recites an application programming interface. Claim 17 recites that the client and the server are on the same machine. Claim 18 recites that the browser and the server are on the same machine. Claim 19 recites that the communications of claim 16 include instructions for backing up at least one client file. Claim 20 recites that the communications of claim 16 include instructions for restoring at least one client file to the client from the server. Claim 21 recites sending the browser a graphical user interface that runs at the browser. Claim 22 recites that the graphical user interface is a JAVA applet.

None of these elements are addressed by the Examiner's Answer. As such, the lack of any argument or support for the rejections of these claims should be seen as an admission that these claims are allowable.

CONCLUSION

For the reasons stated above, claims 1-22 are believed to be allowable, and the Appellant petitions the Board to reverse the Examiner's rejections of claims 1-22.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian C. Kunzler", written over a horizontal line.

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